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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ULM, JOHN D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 07/25/2002 fo

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/698,419

Applicant(s)
Vogeli et al.

Examiner
John Ulm

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1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 11, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 12-48, and 52-77 is/are pending in the application.
- 4a) Of the above, claim(s) 8, 12-44, 52-72, and 74-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-48 and 73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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1) Claims 8, 12 to 48 and 52 to 77 are pending in the instant application.

2) Claims 8, 12 to 44, 52 to 72 and 74 to 77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9. The traversal is on the ground(s) that a search of the different inventions in a single application would pose no undue burden. This is not found persuasive because M.P.E.P. 803 states that:

“ For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.”

Serious burden was shown in the original requirement by the separate classification and separate status in the art of the different inventions. Applicant has provided neither a showing or evidence to the contrary.

The requirement is still deemed proper and is therefore made FINAL.

3) Applicant is required to submit an amendment replacing claims 35 and 45 in response to this action. The amendment which was filed on 27 October of 2000 did not have an adequate top margin. 37 C.F.R. § 1.52(a)(1)(ii) requires that the top of each page of the application must have a margin of at least approximately 3/4 inch (2 cm.). This margin is needed to prevent possible mutilation of text when the papers are punched for insertion in a file wrapper.

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Text has been deleted from the tops of pages 4 and 5 of that amendment because of the lack of an adequate top margin.

4) Claims 47 and 48 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A properly dependant claim can not conceivably be infringed without infringing any of the claims from which it depends. The method of claims 47 and 48 do not require the "isolated and purified" polypeptide of claim 8, from which they depend. See M.P.E.P. 608.01(n)III.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5) Claims 45 to 48 and 73 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed specific and substantial credible utility. The instant application has provided a description of an isolated DNA encoding a protein, the protein encoded thereby and a process of identifying ligands for that protein. The instant application does not disclose a specific biological role for this protein or its significance to a particular disease, disorder of physiological process which one would wish to manipulate for a desired clinical effect.

It is clear from the instant specification that the receptor protein employed in the claimed process is what is termed an "orphan receptor" in the art. This is a protein whose cDNA has been

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isolated because of its similarity to known proteins. There is little doubt that, after complete characterization of the protein employed in the claimed process and the discovery of at least one specific physiological process mediated by that protein, the claimed process may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete.

Whereas one could readily employ a putative receptor protein of the instant invention in an assay to identify ligands thereto the information obtained thereby would be of little use until one discovers the identity of those physiological processes moderated by that putative receptor.

Because the instant specification has failed to credibly identify a physiological process which has been shown to be influenced by the activation or inhibition of a putative receptor protein of the instant invention an artisan would have no way of predicting what effects the administration of that ligand to an organism would have. If one can not predict the effects that the administration of a ligand of the putative receptor of the instant invention is going to have on an organism then it is unclear as to what practical benefit is derived by the public from the identification of that ligand.

The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad

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interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

The instant claims are drawn to a binding assay which specifically employs a protein of as yet undetermined function or biological significance. There is absolutely no evidence of record or any line of reasoning that would support a conclusion the a protein of the instant invention is associated in any way with a disease or disorder of the brain, as asserted on page 3 of the instant specification.. Until some actual and specific significance can be attributed to the protein identified in the specification as "CON202" the instant invention is incomplete. The protein which is employed in the binding assay of the instant invention is a compound known to be structurally analogous to proteins which are known in the art as G protein-coupled receptors. In the absence of a knowledge of the natural ligands or biological significance of this protein, there is no immediately obvious patentable use for it or an assay employing it. To employ a protein of the instant invention in the identification of substances which inhibit or induce its activity is clearly to use it as the object of further research which has been determined by the courts to be a utility

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which, alone, does not support patentability. Since the instant specification does not disclose a credible "real world" use for a ligand of "CON202" then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6) Claims 45 to 48 and 73 are rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to use the instant invention for those reasons given above with regard to the rejection of these claims under 35 U.S.C. § 101.

7) Claims 46, 48 and 73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to practice the claimed invention.

Claim 46 expressly requires an artisan to know the identity of a "binding partner" of the receptor protein being employed in the claimed assay. The instant specification, however, does not identify even a single compound which is capable of functioning as a "binding partner" for a putative G protein-coupled receptor protein comprising the amino acid sequence presented in SEQ ID NO:14 of the instant application. Proteins belonging to the family of G protein-coupled receptors bind a variety of structurally unrelated compounds ranging from simple compounds like glutamate, glycine, dopamine, serotonin, somatostatin and epinephrin to complex molecules such

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as interleukin-8. Further, one can not predict to which ligand the instant receptor will bind by reviewing its amino acid sequence. Therefore, one would have to resort to a substantial amount of undue experimentation consisting of screening essentially every naturally occurring soluble chemical compound present in the human body to identify one which is a "binding partner" for a putative receptor protein of the instant invention. In an analogous manner, claims 48 and 73 require one to measure a physiological parameter effected by the activation of a receptor protein of the instant invention. It is well known in the art that G protein-coupled receptors signal through a variety of different pathways, depending upon the type of G α subunit protein to which a particular receptor is coupled. As with the "binding partner", one can not predict with which type of G α subunit protein a particular G protein-coupled receptor will interact by simply reviewing the amino acid sequence of that receptor protein. Because the instant specification does not identify a specific physiological parameter which has been demonstrated to be modulated by the agonist activation of a protein comprising the amino acid sequence presented in SEQ ID NO:14 of the instant application an artisan can not practice the claimed assay method without first making the substantive inventive contributions of discovering an agonist of that protein and a physiological parameter which can be used to measure the activation of that protein by the agonist. A patent is granted for a completed invention, not the general suggestion of an idea and how that idea might be developed into the claimed invention. In the decision of *Genentec, Inc. v. Novo Nordisk*, 42 USPQ 2d 100,(CAFC 1997), the court held that:

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“[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable” and that “[t]ossing out the mere germ of an idea does not constitute enabling disclosure”. The court further stated that “when there is no disclosure of any specific starting material or of any of the conditions under which a process is to be carried out, undue experimentation is required; there is a failure to meet the enablement requirements that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art”, “[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement”.

The instant specification is not enabling because one can not following the guidance presented therein and practice the claimed method without first making a substantial inventive contribution.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8) Claim 73 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 73 is vague and indefinite in so far as it employs the term “CON202” as a limitation. Because the instant specification does not identify that property or combination of properties which is unique to and, therefore, definitive of the limitation “CON202” an artisan can not determine if a process employing a compound which meets all of the other limitations of a claim would then be included or excluded from the claimed subject matter by the presence of this limitation.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9) Claims 45 to 48 and 73 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by the Elshourbagy et al. patent (6,071,722). The amino acid sequence presented in SEQ ID NO:2 of the Elshourbagy et al. patent is identical to the amino acid sequence presented in SEQ ID NO:14 of the instant application. The text beginning on line 65 in column 10 of the Elshourbagy et al. patent expressly described the methods of the instant claims. This rejection is not in conflict with the enablement rejection above. As stated in *Ex parte Dash*, 27 USPQ2d 1481 (BdPatApp&Int, 1993) “[w]e are not unaware that we are sustaining rejections under lack of enablement based on reasons which also apply to the prior art” and “[i]f appellants overcome the lack of enablement of their claims, they will necessarily overcome the lack of enablement of the references”. All of the elements of the claimed invention were in the prior art. Further, the

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instant specification provides neither an element of predictability that was lacking from the prior art or the disclosure of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800